



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,144	04/14/2004	Ken Kitamura	82478-6500	7827
21611 7590 12/13/2007 SNELL & WILMER LLP (OC) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			EXAMINER THERIAULT, STEVEN B	
			ART UNIT 2179	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,144

Applicant(s)

KITAMURA, KEN

Examiner

Steven B. Theriault

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/04, 09/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: Non-provisional application filed 04/14/2004 with a claim to foreign priority to 4/10/2003. The applicant submitted a preliminary amendment to the claims, prior to any office action on the merits and the Examiner will use the claims submitted 04/14/2004.
2. Claims 1 -13, 16-20 are pending in the case. Claims 1, 8, 9, 13, 16 and 17 are the independent claims. Claims 14 and 15 have been cancelled.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 16, 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

With regard to **claims 16, 17-20**, the computer executable program as recited in all of the claims is referred to in the present application specification as "being distributed as a digital signal over the network." (See below)

[0185] The invention also applies to the methods described above. The methods may be realized by a computer program that can be executed by a computer system. The computer program may be distributed as a digital signal.

[0186] The invention may also be realized by a computer-readable storage medium, such as a flexible disk, a hard disk, a CD, an MO, a DVD, a BD, or a semiconductor memory, on which the computer program or digital signal mentioned above is recorded.

[0187] The computer program or digital signal that achieves the invention may also be transmitted via a network, such as an electronic communications network, a wired or wireless communications network, or the Internet.

[0188] The computer program or digital signal may also be provided to an independent computer system by distributing a storage medium on which the computer program or digital signal is recorded, or by transmitting the computer program or digital signal via a network. The independent computer system may

then execute the computer program or digital signal to function as the invention.

Therefore, the specification provides at least one alternative embodiment where the computer program is recorded on a "digital signal" that is transmitted or distributed over a network to be realized, which creates a scenario where the medium that embodies the computer program as a signal and "a signal" is not statutory under 2106.01. Furthermore, the Independent claims 16 and 17, along with the dependent claims, recite a series of steps to be executed in an apparatus, which in the Examiners interpretation provides the second reason for the 101 rejection. The program as recited in the claims comprises a quasi 112 6th 'step of' instead of the traditional "step for" but nonetheless the claim, as recited, reads as a series of code modules for performing a step but the steps are considered code modules that when executed may perform the step. When taking the claim as a whole the claim reads as a method claim but is claimed as an apparatus claim and nothing in the claim recites that the code modules actually are executed. The claim recites a "step of" as code **"for executing"** but does not include a transformation to realize the steps that actually execute the code. It can be stated that the claim limitations do contain relationships where a step, when executed, would provide data or display data to another module but as stated above the code comprises the modules for executing the step but there does not appear to be an actual transformation of the program on the apparatus to realize the claimed invention. In summary, the steps appear to be software per se and do not recite a transformation of the code to include a tangible result and consistent with MPEP 2106, the claimed subject matter is not currently believed to be limited to that which falls within a statutory category of invention, because in one interpretation, the code is not limited to a process, machine, manufacture, or a composition of matter because the program is considered software per se. Second, the program is defined in the specification as embodied as a signal is considered a form of energy and not a tangible medium to realize a transformation of the code to be structurally and functionally interrelated with the medium.

Remedies to resolve the issues can be directed to, but not limited to, clearly outlining the medium to which the code can execute, such as a computer readable storage medium and

Art Unit: 2179

possibly changing the preamble to recite a method claim, instead of an apparatus, and showing how the interrelated steps are executed to realize a transformation as a concrete and tangible result.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-13, 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Emmerichs et al. (hereinafter Emmerichs) U.S. Patent Pub. No. 20030061482 published Mar. 27, 2003 and filed Aug. 23, 2002.**

In regard to **Independent claim 1**, Emmerichs teaches an information processing apparatus used by a plurality of different operators or operator groups, comprising:

- A form display unit operable to display a form together with information to be processed (See Para 0053 and figure 3). Emmerichs teaches a GUI that displays a form that contains information to be processed.

Art Unit: 2179

- An identification information reception unit operable to receive identification information from a current operator, while the form is being displayed together with the information (Emmerichs Para 0031-0033 and 0054) Emmerichs teaches the user of user profiles and a security system to receive ID information as to whether the user can access the widget.
- An operator identification unit operable to judge whether or not the received identification information identifies a specific operator or operator group (Emmerichs Para 0034 and 0054). Emmerichs teaches the system judges the access to a data type, widget or other graphical element by scanning the system rapidly (See Para 0079).
- And a display change unit operable to make a specific display item which the specific operator or operator group is permitted to operate, appear on the displayed form without changing the displayed information, when the operator identification unit judges in the affirmative (See Para 0079-0080, Figures 3-11 and 0035-0041) Emmerichs teaches the interface checks to see whether a given user profile or ID can access a widget, field or data type. Emmerichs teaches the widget can display a field and without changing the information can make a checkbox available or a radio button based on the user's security profile.

With respect to **dependent claim 2**, Emmerichs teaches the information processing apparatus, wherein when the operator identification unit judges in the affirmative, the display change unit (a) makes the specific display item appear on the displayed form if the specific display item is invisible on the displayed form, and (b) makes the specific display item disappear from the displayed form if the specific display item is visible on the displayed form (See figure 4 and Para 0035-0038). Emmerichs teaches and shows that a given field, button, widget or data type can "not" be displayed or be hidden to/from the user based on access rights and based on the data type and operation the GUI can make a check box, or button available or not available to the user.

Art Unit: 2179

With respect to **dependent claim 3**, Emmerichs teaches the information processing apparatus wherein when the operator identification unit judges in the affirmative, the display change unit further makes, if a display item which the specific operator or operator group is prohibited to operate is visible on the displayed form, the display item disappear from the displayed form (See Para 0035).

With respect to **dependent claim 4**, Emmerichs teaches the information processing apparatus further comprising: a storage unit storing a permission list which shows all operators or operator groups, including the specific operator or operator group, that are permitted to operate the specific display item, wherein the operator identification unit identifies an operator or operator group from the received identification information, and the display change unit makes the specific display item appear on the displayed form, if the identified operator or operator group is included in the permission list (See Para 0031 and 0046). Emmerichs teaches a user security table that manages the user profile, relationships to widgets and security permissions available to a user, which is considered a permissions list (See also Para 0056).

With respect to **dependent claim 5**, Emmerichs teaches the information processing apparatus wherein the received identification information is a character string, operation sequence information, biometric information, or a combination thereof, and the operator identification unit judges in the affirmative, if the received identification information matches a specific character string, specific operation sequence information, specific biometric information, or a combination thereof (See Figure 4 and 11). Emmerichs shows character strings as values for the data type that determines access to a given item on the display. Further, Emmerichs teaches the system can define the ID information in any order suitable to secure the data types (See Para 0043), which can be an operation sequence.

With respect to **dependent claim 6**, Emmerichs teaches the information processing apparatus further comprising: a storage unit storing form definition information which defines the form containing the specific display item, wherein the form display unit displays the form according to the form definition information, in a state where a visibility property of the specific display item is set to invisible, and the display change unit redisplayes the form according to the form definition information, in a state where the visibility property of the specific display item is set to visible (See Para 0035-0042 and 0053). Emmerichs teaches a form is displayed to the user and when a form was defined as having a property that did not allow a user to access a field can change the field dynamically to allow the field to be accessible to the user (See Para 0078), because Emmerichs teaches the changes can be made while the program executes.

With respect to **dependent claim 7**, Emmerichs teaches the information processing apparatus further comprising: an acquisition unit operable to acquire form definition information which defines the form containing the specific display item, from outside the information processing apparatus, wherein the form display unit displays the form according to the form definition information, in a state where a visibility property of the specific display item is set to invisible, and the display change unit redisplayes the form according to the form definition information, in a state where the visibility property of the specific display item is set to visible (See Para 0035-0041 and 0079-0080). Emmerichs teaches the security controls operate outside the application and are stored in a security module. Further, Emmerichs clearly teaches the ability to change a field, button, or widget access to a given user dynamically as the application executes.

In regard to **Independent claim 8**, Emmerichs teaches an information processing system which is used by a plurality of different operators or operator groups and comprises a server apparatus and a client apparatus, wherein the server apparatus includes:

- A form display data transmission unit operable to transmit first data showing a form to the client apparatus (See Para 0053).

Art Unit: 2179

- An identification information receiving unit operable to receive identification information of a current operator, from the client apparatus (See Para 0034). Emmerichs teaches the ID and user profile to access the data types is stored locally on the workstation.
- An operator identification unit operable to judge whether or not the received identification information identifies a specific operator or operator group (See Para 0035-0041). Emmerichs teaches the use of user profiles that can relate to a user or group of users (See also Para 0046).
- A display change data transmission unit operable to transmit second data showing a specific display item which the specific operator or operator group is permitted to operate, to the client apparatus, when the operator identification unit judges in the affirmative (See Para 0046 and 0054-0055). Emmerichs teaches a user accesses a form and the user's security profiles and permissions for a data type will determine if they can access a field if for example the user selects a button and the system sends more information. Emmerichs teaches the system can change the controls as the data types change (See Para 0048). Further, Emmerichs teaches the GUI can be scanned at over a 1000 times a second to check for proper security access.
- And the client apparatus includes: a form display unit operable to receive the first data from the server apparatus, and display the form shown by the first data (See Para 0053 and Figure 3).
- An identification information reception unit operable to receive the identification information from the current operator while the form is being displayed, and transmit the identification information to the server apparatus (See Para 0054) Emmerichs teaches the users security profiles is checked upon access which would allow for the system to access the server, download the users profile, and change the access to the field.
- A display change unit operable to receive the second data from the server apparatus and make the specific display item shown by the second data appear on the displayed form (See figures 3-11 and Figure 3 and Para 0053-0056). Emmerichs teaches sending a web

Art Unit: 2179

form to the user. Emmerichs also teaches data is received as the user interacts with the form and based on the data type the access to the field is governed by the user's permissions to the data type.

In regard to **Independent claim 9**, Emmerichs teaches a method of managing an operator change in an information processing apparatus which is used by a plurality of different operators or operator groups, comprising:

- A form display step of displaying a form together with information to be processed (See Para 0053).
- An identification information reception step of receiving identification information from a current operator, while the form is being displayed together with the information (Emmerichs Para 0031-0033 and 0054) Emmerichs teaches the user of user profiles and a security system to receive ID information as to whether the user can access the widget.
- An operator identification step of judging whether or not the received identification information identifies a specific operator or operator group (Emmerichs Para 0034 and 0054). Emmerichs teaches the system judges the access to a data type, widget or other graphical element by scanning the system rapidly (See Para 0079).
- And a display change unit operable to make a specific display item which the specific operator or operator group is permitted to operate, appear on the displayed form without changing the displayed information, when the operator identification unit judges in the affirmative (See Para 0079-0080, Figures 3-11 and 0035-0041) Emmerichs teaches the interface checks to see whether a given user profile or ID can access a widget, field or data type. Emmerichs teaches the widget can display a field and without changing the information can make a checkbox available or a radio button based on the user's security profile.

With respect to **dependent claim 10**, Emmerichs teaches the method wherein when the operator identification step judges in the affirmative, the display change step (a) makes the specific display item appear on the displayed form if the specific display item is invisible on the displayed form, and (b) makes the specific display item disappear from the displayed form if the specific display item is visible on the displayed form (See figure 4 and Para 0035-0038). Emmerichs teaches and shows that a given field, button, widget or data type can "not" be displayed or be hidden to/from the user based on access rights and based on the data type and operation the GUI can make a check box, or button available or not available to the user.

With respect to **dependent claim 11**, Emmerichs teaches the method wherein when the operator identification step judges in the affirmative, the display change step further makes, if a display item which the specific operator or operator group is prohibited to operate is visible on the displayed form, the display item disappear from the displayed form (See Para 0035).

With respect to **dependent claim 12**, Emmerichs teaches the method wherein the specific display item is associated with a permission list which shows all operators or operator groups, including the specific operator or operator group, that are permitted to operate the specific display item, the operator identification step identifies an operator or operator group from the received identification information, and the display change step makes the specific display item appear on the displayed form, if the identified operator or operator group is included in the permission list (See Para 0031 and 0046). Emmerichs teaches a user security table that manages the user profile, relationships to widgets and security permissions available to a user, which is considered a permissions list (See also Para 0056).

Art Unit: 2179

In regard to **Independent claim 13**, Emmerichs teaches a method of managing an operator change in an information processing system which is used by a plurality of different operators or operator groups and includes a server apparatus and a client apparatus, comprising:

- A form display data transmission step, performed by the server apparatus, of transmitting first data showing a form to the client apparatus;
- An identification information receiving step, performed by the server apparatus, of receiving identification information of a current operator from the client apparatus;
- An operator identification step, performed by the server apparatus, of judging whether or not the received identification information identifies a specific operator or operator group; a display change data transmission step, performed by the server apparatus, of transmitting second data showing a specific display item which the specific operator or operator group is permitted to operate, to the client apparatus, when the operator identification step judges in the affirmative;
- A form display step, performed by the client apparatus, of receiving the first data from the server apparatus, and displaying the form shown by the first data;
- An identification information reception step, performed by the client apparatus, of receiving the identification information from the current operator while the form is being displayed, and transmitting the identification information to the server apparatus;
- And a display change step, performed by the client apparatus, of receiving the second data from the server apparatus, and making the specific display item shown by the second data appear on the displayed form.

In regard to claims 16-20, claims 16-20 reflect an apparatus and system comprising computer readable instructions for performing the method steps of claims 13 and 9-12, respectively, and are rejected along the same rationale.

It is noted that any citation to specific pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re *Heck*, 699 F.2d 1331, 1332-

Art Unit: 2179

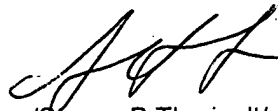
33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



/Steven B Theriault/
Patent Examiner
Art Unit 2179